

ESTTA Tracking number: **ESTTA114943**

Filing date: **12/15/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78591138
Applicant	Opt It, Inc.
Applied for Mark	OPT IT
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Submission	Appeal Brief
Attachments	78591138 appeal brief.pdf (26 pages)(271142 bytes) 78591138 appeal exhibits.pdf (41 pages)(2249134 bytes)
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Date	12/15/2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Application of:)	
Opt It, Inc.)	Law Office:
191 N. Wacker Drive, Suite 2350)	104
Chicago, IL 60606)	Trademark Examining Attorney:
An Illinois Corporation)	Carol Spils
)	
Serial No.)	ESTTA Tracking Number
78/591,138)	ESTTA105138
Filed:)	
March 20, 2005)	
MARK:)	
OPT IT and Design)	

Mail Stop: TTAB NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Electronic Transmission Transmittal Letter
(67 Total Pages including this Transmittal Letter)

1. We are transmitting electronically herewith:

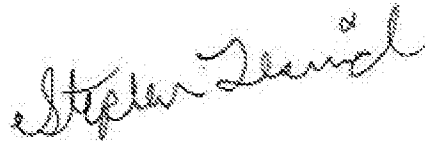
- ☒ APPELLANT BRIEF UNDER 37 C.F.R. §2.142 (25 pages)
- ☒ EXHIBITS A-I (41 pages).

2. GENERAL AUTHORIZATION TO CHARGE OR CREDIT FEES: No fees are required. Should this assumption be incorrect, please charge any additional fees or credit overpayment to Deposit Account No. 50-2281 for Lesavich High-Tech Law Group, P.C. (32097)

3. CERTIFICATE OF TRANSMISSION UNDER 37 CFR § 1.8: The undersigned hereby certifies that this Transmittal Letter and the papers, as described in paragraph 1, are being electronically transmitted to the U.S. Patent and Trademark Office via the USPTO web-site esta.uspto.gov the December 15, 2006.

Respectfully submitted,

Lesavich High-Tech Law Group, P.C. (32097)



Dated: December 15, 2006

Stephen Lesavich

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APPELLANT BRIEF UNDER 37 C.F.R. §2.142

In re Opt It, Inc.

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Date: December 15, 2006

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DESCRIPTION OF RECORD

On March 20, 2005, Appellant filed an application to register on the Principal Register its mark, OPT IT and Design via application number 78/591,138.

On October 19, 2005, the Examining Attorney issued a non-final Office Action to refuse registration of Appellant's mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the grounds that the mark when used on the identified goods and services so resembles U.S. Reg. No. 2,101,964 as to be likely to cause confusion, mistake, or to deceive.

On March 30, 2006, Appellant filed its first and timely Response to the Office Action dated October 19, 2005. In this Response, Appellant prepared arguments to contest the Examining Attorney's refusal to register, submitted a substitute specimen and signed declaration under 37 C.F.R. §2.20 and included a color claim and color description of the mark and notified the U.S. Trademark Office the Appellant is the owner of prior registration 3,068,068 for the word mark, OPT IT.

On April 21, 2006, the Examining Attorney issued a FINAL Office Action to maintain her refusal to register Appellant's mark, under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

On October 19, 2006, Appellant filed its second and timely Response to the FINAL Office Action dated April 21, 2006.

On October 19, 2006, Appellant filed its timely Notice of Appeal with the Trademark Trial and Appeal Board, along with the required fee.

This Brief of Appeal has been timely filed within sixty (60) days of the Notice of Appeal, pursuant to 37 C.F.R. §2.142(b)(i) or by December 18, 2006.

STATEMENT OF ISSUES

Appellant hereby appeals to the Trademark Trial and Appeal Board from the final decision of the Examining Attorney dated April 21, 2006, which refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the grounds that the mark when used on the identified goods and services so resembles Reg. No. 2,101,964 as to be likely to cause confusion, mistake, or to deceive.

Recitation of Facts

On March 24, 2005, Appellant filed this application to register on the Principal Register its composite mark, **OPT IT and Design**.


Trademark:		Application No.: 78/591,138
Applicant:	Opt It, Inc. 191 N. Wacker Drive, Suite 2350 Chicago, IL 60606	
Goods and Services: Computer Software, namely, computer software for text messaging in International Class 009.		

Table 1.

The mark includes a color claim wherein the colors red and white are claimed as a feature of the mark; and the color red appears inside the two circles and the color white appears in the outline of the circles and in the wording OPT IT.

Appellant is also the owner of U.S. Registration No. 3,068,068 for the word mark, **OPT IT**, for advertising services, namely, providing special offers, promotions and updates for others via text messaging in International Class 35.

In her First Office Action dated October 19, 2005, the Examining Attorney cited the following registration as grounds for refusal to register Appellant's mark:

Trademark:	OPT!	Registration No. 2,101,964
Registrant:	Unicom Sales Associates, Inc. 1054 Belair Court Mountainside, NJ 07092	
Goods and Services:	Computer program for managing personal and business contacts; organizing personal information; keeping calendar and personal reminders; keeping history of contacts; keeping record of expenses; making phone calls; sending/receiving faxes and E-mail; and printing letters, labels, envelopes, phone books, address books, and contact details in International Class 9.	

Table 2.

On April 21, 2006, the Examining Attorney issued a FINAL Office Action to refuse registration of Appellant's mark based on the mark listed in Table 2.

On October 19, 2006, Appellant filed its Response to the FINAL Office Action.

On October 19, 2006, Appellant filed its timely Notice of Appeal to contest the decision of the Examining Attorney to refuse registration of its mark.

SUMMARY OF ARGUMENTS

Appellant has raised the following arguments in support of its appeal:

- 1) There is no likelihood of confusion because the Appellant's and registrant's are different in sound, appearance and connotation:
 - a) OPT is not the dominant portion of Appellant's mark because the design portion of the composite mark OPT IT and Design forms a distinct commercial impression by itself.
 - b) Consumers with a fallible memory and a general impression are likely to remember the Appellant's mark design features and not be confused.
- 2) There is no likelihood of confusion because the goods and services of Appellant and registrant are sold in dissimilar established and likely-to-continue trade channels and do not compete with each other;
- 3) There is no likelihood of confusion because Appellant's and registrant's marks are targeted at different types of purchasers;
- 4) The description of the Appellant's and registrant's marks are specific, do limit the channels of trade and do not both provide software for text messaging;
- 5) There is no likelihood of confusion because the Appellant's and registrant's mark have been used for years in commerce without any actual confusion; and
- 6) There can be likelihood of confusion between the Appellant's composite mark and registrant's mark because the U.S. Trademark Office has already allowed registration of the word portion of the mark, OPT IT to the Appellant.

ARGUMENTS

1) There is no likelihood of confusion because the marks OPT IT and DESIGN and OPT! are different in sound, appearance and connotation.

The Examining Attorney refused registration of Appellant's mark based on the belief that the word OPT is the dominant portion of Appellant's mark. Based on this rationale, the Examining Attorney concluded that the appearance of the word OPT in both the registrant's and Appellant's marks creates a likelihood of confusion. Appellant disagrees with this analysis and believes that the Examining Attorney has erred in her reading and application of trademark law.

Appellant submits that the composite mark OPT IT and Design, creates a distinct impression in the eyes of the consuming public, which, when compared in its entirety to registrant's design mark bears little if any resemblance in sound, appearance or connotation.

The Appellant has previously submitted persuasive arguments as to why the marks are different in sound, appearance and connotation. See Exhibit A.

a) OPT is not the dominant portion of Appellant's mark because the design element of the composite mark OPT IT and Design forms a distinct commercial impression by itself.

It is well established in Trademark Law by the Court of Appeals of the Federal Circuit (Federal Circuit) how composite marks should be analyzed in a likelihood of confusion analysis. The Examining Attorney by her own words appears to ignore this controlling case law.

The Federal Circuit has ruled that, "there is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or designs dispositive of the issue." *In re Electrolyte Labs, Inc.* 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990) and the comparison of composite marks must be done on a case-by-case basis without

reliance on mechanical rules of construction. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.* 748 F.2d 669 (Fed. Cir. 1984). The Federal Circuit has also held that likelihood of confusion cannot be predicated on dissection of a composite mark, that is, only on part of a mark. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750, 751 (Fed. Cir. 1985) and the fundamental rule for composite marks is that composite marks must be considered in their entirety. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492, F.2d 1399 (CCPA 1974).

Appellant submits that its composite mark, viewed as a whole in its entirety, instead of just focusing improperly on the formative word OPT, is a mark that forms a distinct commercial impression, and is thus immediately distinguishable from registrant's mark.

b) Consumers with a fallible memory and a general impression are likely to remember the Appellant's design features and not be confused.

In addition, the TTAB has also ruled with respect to marks including design features, it is well established that the test to be applied in determining likelihood of confusion is not whether the marks are distinguishable upon side-by-side comparison but rather whether they so resemble one another as to be likely to cause confusion, and this necessarily requires consideration of both the fallibility of memory over a period of time and also the fact that the average purchaser retains a general rather than a specific impression of the many trademarks he encounters. *In re Muck Duck Mustard Co., Inc.* 6 USPQ.2d 1467, 1468 (TTAB 1988)

The Appellant's mark includes two words and at least four very unique color design elements including two white arrows and two red circles, as is illustrated above in Table 1. The formative words, OPT and IT appear in a colored circles wherein the letter "P" and letter "T" are accented with arrows. In addition, the Appellant's mark includes an additional word IT, not included on the registrant's mark and does not include the exclamation sign "!" included on

the registrant's mark.

The average purchaser when viewing the Appellant's mark in its entirety would be drawn to the unique colorful design features of the mark. Thus, the average purchaser would thus retain a general impression of the colorful design features of the Appellant's composite mark. An average purchaser simply would not confuse the Appellant's design mark including its colorful design features with the registrant's word mark considering the fallibility of memory over a period of time and a general recollection.

The Federal Circuit has supported this conclusion in other similar cases comparing composite and word marks. *See e.g., In re Electrolyte Labs, Inc., 1240* where K+ with design features was used for dietary potassium supplement was held not likely to be confused with K+EFF for a dietary potassium supplement; and *Spice Islands, Inc. v. The Frank Tea Co.* 505 F.2d 1293 (CCPA 1974) where SPICE TREE and tree design was held not confusingly similar to SPICE ISLANDS and tree designs, both for spices. The Trademark Examining Attorney should note, in both of these cited cases, the marks had an identical first word (i.e., K+ and SPICE) in combination with design features and were held not to be confusingly similar. This controlling case law is contrary to the Examining Attorney's assertions.

Therefore, there can be no confusion based on the commercial impression of the Appellant's and the registrant's mark. It is thus very unlikely that any consumer could confuse the source of Appellant's and registrant's goods based on their respective marks.

2) There is no likelihood of confusion because the goods and services of Appellant and registrant are sold in dissimilar established and likely-to-continue trade channels and do not compete with each other.

The existence of dissimilar, established and likely-to-continue trade channels are important factors that mitigates likelihood of confusion as to the source of goods in the instant

case. Even if the goods are similar, and in this matter, they clearly are not, the different well established and likely-to-continue channels of trade are highly relevant factors in making a likelihood of confusion determination. *In re N.A.D., Inc.*, 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985). The Federal Circuit has also held there is less chance of likelihood of confusion if there is no conflict between two channels of trade. *In re Dixie Restaurants, Inc.* 41 U.S.P.Q.2d 1531, 1354 (Fed. Cir. 1997). See also, *In re The Shoe Works Inc.*, 6 U.S.P.Q.2d 1890, 1891 (TTAB 1988).

Appellant submits that its mark can be distinguished from registrant's mark because the goods of the parties have been sold in highly specific marketing channels and are therefore not subject to a likelihood of consumer confusion. Moreover, it is well established that trademarks used in connection with products in the computer and information technology industry can be sufficiently distinct that they do not lead to likely consumer confusion. For example, in *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270, 60 U.S.P.Q.2d 1609 (3rd Cir. 2001), the Court of Appeals held that CHECKPOINT electronic security monitoring devices were not likely to be confused with CHECK POINT firewall software. Despite the virtually identical nature of the marks, which is not the case in the present matter, and some overlap in the industries, the court reasoned that:

[B]ecause the products served different functions, and there is only "minimal overlap" in the product technology, it is unlikely consumers would be confused by the similar marks... [and] because the products of each party were marketed to different users, the court concluded there was not a strong likelihood that users and consumers of the parties' products were likely to cause confusion. *Id.* at 289.

This court decision is consistent with the approach taken by the TTAB in technology related cases:

As a result of the veritable explosion of technology in the computer field over the last

several years and the almost limitless number of specialized products and specialized uses in this industry, a *per se* rule relating to source confusion vis-à-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace. Tendencies toward applying “*per se*” rules relating to likelihood of confusion in other fields have been struck down as being too inflexible and contrary to trademark law where each case must be decided based on its own facts and circumstances.

In re Quadram Corporation 228 U.S.P.Q. 863,865 (TTAB 1985).

In this matter, Appellant’s goods are sold in the U.S. through its sales consultants, who not only sell the software, but provide training and technical support to an advertiser (www.optit.com) See Exhibit B. An advertiser purchases a mobile domain name to allow advertising via text messaging via the Appellant’s software. For example, the Avalon, a night club in Boston, MA purchased a mobile domain name called, AVALON. See Figure 1.

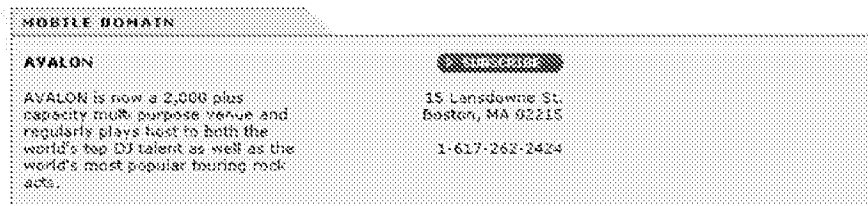


Figure 1.

A mobile domain names allow a subscriber to sign up directly from their mobile phone. The mobile domain name purchased by the advertiser require setup and cooperation of the major telecommunications carriers including Verizon, Cingular/AT&T, Nextel, T-Mobile, Sprint, U.S. Cellular, Alltel, etc. for use via the Appellant’s software.

A user who visits the Avalon in Boston can subscribe to text message advertising. See Figure 2.


PROVIDER RESULTS		
Category	Mobile Domain Name	Description
	avalon	AVALON is now a 2,000 plus capacity multi purpose venue and regularly plays host to both the world's top DJ talent as well as the world's most popular touring rock acts.

Figure 2.

After subscribing, the Avalon will send targeted advertisements via text messaging to subscribers for drinks, food, etc. while the subscriber is in the Avalon. See Figure 3.

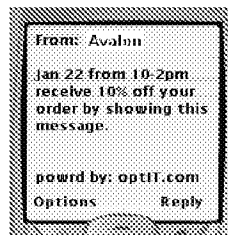


Figure 3.

The Appellant developed software for one of the first permission-based mobile portals for receiving local advertising information directly on mobile phones and other mobile devices such as personal digital assistants, pagers, etc. via text messaging. The software includes mobile opt-in communications via text messaging for clients on a local and national level. These communications empower businesses and organizations to reach their audience via targeting text messaging with higher visibility and greater response rates. Subscribers join an advertising group through their mobile phones and are subscribed to a group automatically via the software. A double opt-in process ensures that mobile phone numbers received from a website and any third party websites are accurate and authenticated.

Appellant's software forms a core component of directed text messaging advertising for an advertiser. End users of the software are subscribers who wish to receive advertising via text

messaging.

In stark contrast to Appellant's software, registrant's software (when it was in use) was designed for managing personal and business contacts and organizing personal information on a desktop computer. The registrant's software was marketed to users of desktop computers who desired to store and organize personal and business information. The registrant's software did not include text messaging because text messaging was not commercially available in the US when the registrant's application was filed (See Argument 4 below). The registrant's software did not require the cooperation of major telecommunications providers to set up and use. The registrant's software did not provide advertisers with a mechanism to send directed advertising via text messaging.

The Appellant could not find any current product marketed or for sale under the OPT!, trademark. The registrant, now describes itself at (www.usgi.com/index.html) as

A Computer and Network services company dedicated in providing Hardware, Software, Installation/Integration Consultancy, and Maintenance Services for our customers throughout New Jersey and surrounding area including New York and Long Island. See Exhibit C.

It is clear, therefore, that Appellant's and registrant's goods appear in divergent markets, each with its own unique appeal and audience. It is evident that Appellant and registrant did not and still do not compete with each other.

Appellant sells and registrant sold their goods through widely different channels of trade to totally different consumer bases. This factor strongly mitigates against any likelihood of confusion. Therefore, there would not be any confusion towards the source of the Appellant's and registrant's services based on their dissimilar established and likely-to-continue trade channels.

2) There is no likelihood of confusion because Appellant's and registrant's marks are targeted at different types of purchasers.

The courts have consistently held that confusion is less likely where the goods are expensive and purchased by discerning buyers. Since Appellant's goods are targeted toward sophisticated purchasers, and the registrant's were not, no consumer confusion is unlikely to occur. In *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992), the Federal Circuit found no likelihood of confusion where the plaintiff sold E.D.S. computer services to "experienced corporate officials after significant study and contractual negotiation," while the defendant sold EDS power supplies and battery chargers to OEMs. The Court reasoned that both parties' goods and services "are usually purchased after careful consideration by persons who are highly knowledgeable."

In *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 U.S.P.Q. 786 (1st Cir. 1983), the First Circuit found no confusion. The court held the "most critical factor" to be the sophistication of the buyers of the products. *Id.* at 1206. The court held that considering the sophistication of purchasers, dissimilarities of the goods and diverse channels of trade, there was no likelihood of confusion between the identical marks. *Id.* See also *Magnaflux Corp. v. Sonoflux Corp.*, 231 F.2d 669, 109 U.S.P.Q. 313 (C.C.P.A. 1956) (In finding no likelihood of confusion, the court held that "confusion is less likely where goods are expensive and are purchased after careful consideration than where they are inexpensive and are purchased casually." *Id.* at 671); *L. J. Mueller Furnace Co. v. United Conditioning Corp.*, 222 F.2d 755, 106 U.S.P.Q. 112 (C.C.P.A. 1955) (In making purchasing decisions regarding "expensive" goods, the reasonably prudent person standard is elevated to the standard of the "discriminating purchaser." *Id.* at 758).

In the present matter, Appellant's mark is used in connection with the sale of targeted advertising via text messaging. The Appellant charges a fee of several thousands of dollars to cover the cost of setting up an account and creating a mobile domain name to allow people to subscribe to a group from their mobile phone to receive advertising via text messaging. The Appellant's goods are purchased after careful negotiation and consideration by sophisticated advertisers who want to target technologically savvy subscribers with advertising received via text messaging.

In direct contrast, the registrant's software was purchased casually at a much lower price by a general group of unsophisticated consumers without negotiation and careful consideration who had a computer and desired to manage personal and business information.

For this reason, there can be no likelihood of confusion as to the source of the goods based on the care and degree of sophistication of purchasing, or lack thereof between the Appellant's and registrant's marks.

3) The description of the Appellant's and registrant's marks are specific, do limit the channels of trade and do not both provide software for text messaging.

The Trademark Examining Attorney by her own words states, "It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973).

The Appellant has explained in detail to the Examining Attorney the technical differences of text messages and e-mail. See Exhibit A. They are clearly not equivalent

technologies. Yet, the Examining Attorney incorrectly implies equivalence yet again. This is another clear error in the application of trademark law and her understanding of technology.

The Examining Attorney asserts “Both of the marks are used to identify computer programs/software for text messaging or sending/receiving emails.”

As is illustrated in Table 1 above, the Appellant’s mark identifies goods including computer software, namely computer software for text messaging. E-mail is not identified in the Appellant’s description of goods.

As is illustrated in Table 2 above, the registrant’s mark identifies goods including a computer program for in part use for “sending/receiving faxes and E-mail.” Text messaging is not identified in the registrant’s description of goods.

The Examining Attorney then asserts “Please see the attached X-Search evidence, which illustrates that the same marks identify both text messaging or emailing telecommunication services. Please see the attached Nexis® evidence which illustrates that the same software provides both text messaging and emailing.”

However, none of the evidence cited by the Examining Attorney is even remotely relevant to the present matter. Neither the Appellant’s nor the registrant’s products or marks are included anywhere in the cited evidence. Nor are the products cited in the evidence even remotely similar to the Appellant’s or the registrant’s products. The evidence shows nothing more than the Examining Attorney found the two words “e-mail” and “text messaging” in the same electronic document. None of the evidence was from the time frame (i.e., 1995) when the registrant filed its application. In fact, the alleged evidence cited by the Examiner is contrary to the facts and further supports the Appellant’s arguments listed below and has dates well after the registrant file its trademark application and received its registration.

In addition, the Examining Attorney's assertion that the registrant's goods include text messaging, even though the description of goods does not specifically state, text messaging is yet another error in the application of trademark law.

First, an Examining Attorney cannot, *sua sponte*, just decide to add items to a description of goods, when the item (i.e., text messaging) was not clearly not identified by the registrant. This violates trademark rules and trademark law, is inequitable, and would make the U.S. Trademark system unusable. Think of the chaos that would result if a Trademark Examining attorney could add items not identified in a description of goods to reject a mark with a likelihood of confusion rejection for an applicant. That is why an applicant is required to include a description of its goods or services. No applicant would ever be able to get a mark registered in such a scenario. The case law clearly states the likelihood of confusion between marks must be determined on the basis of the goods or services as they are identified in the application and the registration.

Second, the registrant's mark was filed in 1995 and registered on September 30, 1997. Text messaging (technically called Short Message Services (SMS), see Exhibit A) was likely not included in the description of goods because text messaging was not commercially available in the United States on any telecommunications networks during that time period and certainly not available from desktop computer programs described the registrant at that time. See Exhibit D which is a press release that states PrimeCo (now part of Verizon) a major mobile telecommunications company was just beginning testing of short message services (SMS) (i.e., text messaging) for the first time in December 1997, and planned to complete the rollout by late the next year (i.e., 1998) for mobile phones. Exhibit E is an article from the Miami Herald dated June 26, 2001, that states the top four wireless handset makers announced their SMS

initiative in April of 2001 to allow text messaging between different carriers for the first time. Exhibit F is an article dated 2004, that states that in the United States in 2004 SMS service was practically non-existent. Exhibit G is an article from USA Today from July 27, 2005, just over a year ago that states text messaging on cell phones is now only finally taking off in the USA and has only caught on in the last year or so (i.e., since 2004).

Finally, the registrant did not file any additional applications for the, OPT!, mark or any other that the Appellant can find including text messaging in the description of goods. This is additional evidence the registrant did not intent to include text messaging as part of its goods protected by any trademarks.

The Examining Attorney then asserts "Since the identification of the registrant's and applicant's goods is very broad and does not limit the channels of trade, it is presumed that the registration and the application encompasses all goods of the type described and that they move in all normal channels of trade and that they are available to all potential customers."

This is clearly another incorrect application of trademark law. The Appellant's description of goods is clearly not broad, but is instead very narrow and specific, *computer software, namely, computer software for text messaging*. Computer software for text messaging. Period. It includes nothing else. There are no more words. No other identified uses for the computer software. Simply, computer software for text messaging.

In addition, the registrant's description of its goods is not broad, but also very narrow and specific as well. It lists a computer program with eight specific distinct items separated by colons for managing personal and business information: "*Computer program for managing personal and business contacts; organizing personal information; keeping calendar and personal reminders; keeping history of contacts; keeping record of expenses; making phone calls;*

sending/receiving faxes and E-mail; and printing letters, labels, envelopes, phone books, address books, and contact details.

The registrant's appeared to take great care in specifically and narrowly describing the components of its computer program, which does NOT include text messaging. If text message was part of the functionality of the registrant's goods, it would likely have been included based on the specificity of its description of goods. It wasn't included because text messaging was not commercially available in the United States when the registrant filed its application.

Thus, the Examining Attorney has improperly based part of her likelihood of confusion analysis based on items not actually identified in the Appellant's and the registrant's actual description of goods in violation of the holding of trademark law.

5) There is no likelihood of confusion because the Appellant's and registrant's mark have been used for years in commerce without any actual confusion.

Appellant's mark has been used extensively in commerce since 2003. Registrant's mark was registered in 1997. Appellant can find no current product being marketed or sold under the, OPT!, trademark. Since 2003, there has not been any actual confusion at all has with registrant's mark the Appellant is aware of. The Third Circuit has held that,

[I]f a defendant's product has been sold for an appreciable period of time without evidence of actual confusion, one can infer that continued marketing will not lead to consumer confusion in the future. The longer the challenged product has been in use, the stronger this inference will be.

Versa Prods. Co. v. Bifold Co., 50 F.3d 189, 205, 33 U.S.P.Q.2d 1801 (3d Cir. 1995), *cert.*

denied, 516 U.S. 808, 133 L. Ed. 2d 19, 116 S. Ct. 54 (1995) (no likelihood of confusion found).

Similarly, in *Aktiebolaget Electrolux v. Armatron Intern., Inc.*, 999 F.2d 1, 3, 27 U.S.P.Q.2d 1460 (1st Cir. 1993), the First Circuit held that:

An absence of actual confusion, or a negligible amount of it, between two products after a long period of coexistence on the market is highly probative in showing that little likelihood of confusion exists.

In spite of extensive use in the US market of Appellant's mark via the Internet, no actual confusion has been found. This factor strongly mitigates against any likelihood of confusion. Therefore, there would not be any confusion towards the source of the Appellant's and registrant's services based on no actual confusion.

- 7) **There is no likelihood of confusion between the Appellant's composite mark and registrant's mark because the U.S. Trademark Office has already allowed registration of the word portion of the mark, OPT IT to the Appellant.**

Appellant is also the owner of U.S. Registration No. 3,068,068 for the word mark, **OPT IT**, for advertising services, namely, providing special offers, promotions and updates for others via text messaging in International Class 35. See Exhibit H. The Appellant made the Examining Attorney aware of the existence of this registered mark for the Appellant, as she did not mention it in any of her office actions. The Examining Attorney apparently did not include this prior registration by the Appellant in her analysis.

In an Office action dated October 17, 2005, for the application that led to the registration, another Trademark Examining Attorney in the same Law Office 104 in that matter asserted "The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d)." See Exhibit I. No confusion was found between this word mark, OPT IT, and the registrant's word mark, OPT!, by the U.S. Trademark Office.

In the present matter, the Appellant's mark includes the same formative words, OPT IT, formative words for which it already received a registration, and additional colorful design

features not included with the registrant's mark. The Appellant submits to the Board that rejecting the mark OPT IT and design, with additional design features when the Appellant already has a registration on the formative words without the design features is clearly another error by the Examining Attorney in applying trademark law.

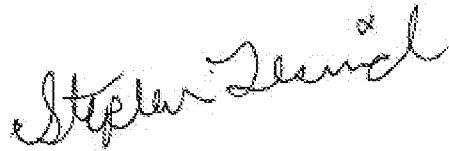
CONCLUSION

For the reasons set forth above, Appellant submits that there is no likelihood of confusion, mistake, or deception between Appellant's mark and the prior cited registration. Accordingly, Appellant's mark is clearly entitled to registration. The Board is therefore respectfully requested to reverse the Examining Attorney's decision refusing registration of Appellant's mark and request the Examining Attorney immediately pass the mark to publication.

Sincerely,

ATTORNEY FOR THE APPELLANT

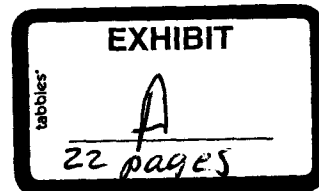
Lesavich High-Tech Law Group, P.C.



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Date: December 15, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(LHTLG No. 05,123)



In the Application of:
Opt It, Inc.
191 N. Wacker Drive, Suite 2350
Chicago, IL 60606
An Illinois Corporation

)
) Law Office:
) 104
) Trademark Examining Attorney:
) Carol Spils

In re Opt It Inc.
Serial No. 78/591,138

Serial No. 78/591,138

Filed: March 20, 2005

MARK: OPT IT and Design

Facsimile Transmittal Letter

(22 Total Pages including this Transmittal Letter)

1. We are transmitting herewith:

☒ Response to Office Action E-mailed October 19, 2005 (21 pages).

2. **GENERAL AUTHORIZATION TO CHARGE OR CREDIT FEES:** No fees are required. Should this assumption be incorrect, please charge any additional fees or credit overpayment to Deposit Account No. 50-2281 for Lesavich High-Tech Law Group, P.C. (32097)

3. **CERTIFICATE OF TRANSMISSION UNDER 37 CFR § 1.8:** The undersigned hereby certifies that this Transmittal Letter and the papers, as described in paragraph 1, are being facsimile transmitted to the U.S. Patent and Trademark Office facsimile number (571) 273-9104 for Law Office 104 on the 30th of March 2006.

Respectfully submitted,

Lesavich High-Tech Law Group, P.C. (32097)

A handwritten signature in cursive script, appearing to read "Stephen Lesavich".
Stephen Lesavich

Dated: March 30, 2006

1 of 1

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TRADEMARK 78/591,138

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(LHTLG No. 05,123)

In the Application of:)	
Opt It, Inc.)	Law Office:
191 N. Wacker Drive, Suite 2350)	104
Chicago, IL 60606)	Trademark Examining Attorney:
An Illinois Corporation)	Carol Spils
)	
Serial No. 78/591,138)	
)	
Filed: March 20, 2005)	
)	
MARK: OPT IT and Design)	



Response to Office Action E-Mailed October 19, 2005

Applicant hereby responds to the Office Action e-mailed October 19, 2005.

Applicant respectfully requests that the Trademark Office enter the following remarks.

REFUSAL UNDER SECTION 2(d): LIKELIHOOD OF CONFUSION

The Trademark Examining Attorney "refuses registration under the Trademark Act Section 2(d) because the Applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 2,101,964 (hereinafter registrants' mark) as to be likely to cause confusion, to cause mistake or to deceive." The Applicant traverses this refusal and responds as follows.

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Standard for Determining Likelihood of Confusion

The question to be determined for likelihood of confusion is not whether the actual goods or services are likely to be confused, but rather whether there is a likelihood of confusion as to the source of the goods or services because of the marks used thereon. *In Re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984). As explained, below there is no likelihood of confusion as to the source of Applicant's goods and services.

1. Similarity of Marks

The Trademark Examining Attorney asserts that that the registrant's word mark, OPT! and the Applicant's design mark OPT! IT! and design "are highly similar in that both marks contain OPT." Applicant traverses, in the sections that follow, the Trademark Examining Attorney's refusal as to each of the cited *Du Pont* factors and submits that the Trademark Examining Attorney has ignored significant aspects of the of appearance, sound, connotation and commercial impression of Applicant's and registrant's marks.

(a) Appearance

The Trademark Examining Attorney asserts that "with regard to design marks when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and be used in calling for the goods and services. Thus, the word portion, and not the design portion of the mark(s) will be most likely impressed upon purchaser's memory and used by purchasers in calling for the goods." The Trademark Examining Attorney

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has also cited Trademark Trial and Appeal Board (TTAB) precedence (omitted here) to support her conclusion.

Applicant traverses these assertions and submits that it is well established by the Court of Appeals of the Federal Circuit (Federal Circuit) how design marks should be analyzed in a likelihood of confusion analysis.

The Federal Circuit has ruled that, "there is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or designs dispositive of the issue." *In re Electrolyte Labs, Inc.* 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990) and the comparison of composite marks must be done on a case-by-case basis without reliance on mechanical rules of construction. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.* 748 F.2d 669 (Fed. Cir. 1984). The Federal Circuit has also held that likelihood of confusion cannot be predicated on dissection of a mark, that is, only on part of a mark. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750, 751 (Fed. Cir. 1985).

The Applicant's mark includes two words and at least four very unique design elements including two arrow and two circles, as is illustrated below.



In direct contrast, the registrant's mark includes a single word, OPT!, without any design elements. The average purchaser when viewing the Applicant's mark in its entirety would be drawn to the unique design features of the mark. An

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average purchaser simply would not confuse the Applicant's design mark with the registrant's word mark based on appearance. In addition to the design features, the Applicant's mark includes an additional not included in the registrant's mark.

Since marks tend to be perceived in their entirety, and all components of the mark must be given the appropriate weight, there would be no confusion with between the Applicant's design mark and the registrant's word mark as to the source of their own goods.

There is also other case law in support of the Applicant's position with respect to comparing composite marks with word marks. *See e.g., In re Electrolyte Laboratories, Inc., 1240* where K+ with design features was used for dietary potassium supplement was held not likely to be confused with K+EFF for dietary potassium supplement; and *Spice Islands, Inc. v. The Frank Tea Co.* 505 F.2d 1293 (CCPA 1974) where SPICE TREE and tree design was held not confusingly similar to SPICE ISLANDS and tree designs, both for spices. The Trademark Examining Attorney should note, in both of these cited cases, the marks had an identical first word (i.e., K+ and SPICE) in combination with design features and were held not to be confusingly similar.

In addition, the TTAB has also stated that the recollection of an average purchaser to design features of a mark is often of a "general nature." *Red Carpet Corp. v. Johnstown American Enterprises Inc.* 7 U.S.P.Q.2d 1404 (TTAB 1988). An average purchaser would probably retain a general visual impression of the Applicant's mark as a design of multiple circles and arrows. This impression of the

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Applicant's mark would be facilitated by the design elements. In contrast, with respect to the registrant's mark, the average purchaser would formulate a general impression without the benefit of any design features

Thus, there can be no confusion based on the appearance of the Applicant's and the first registrant's mark. It is thus very unlikely that any consumer could confuse the source of Applicant's and registrant's goods based on the appearances of their respective marks.

(b) Similarity in Sound

The Trademark Examining Attorney made no comments about the sound of the Applicant's mark, even though she stated it is one of the criteria that must be considered. In fact, these two marks do not sound anything alike.

The overall sound of the marks is entirely distinct for several reasons. First, registrant's mark is one syllable mark, OPT, with an exclamation point "!". The Blue Book of Grammar and Punctuation at (www.grammarbook.com/punctuation/exclaim.asp) states exclamation points are used to "show emphasis or surprise." Thus, by the rules of grammar, the registrant's mark would be recognized and remembered with a hard emphasis on the formative word, OPT!, because of the exclamation point.

In direct contrast, the word portion of the Applicant's design mark is a two syllable mark OPT•IT, with two "T" sounds. Thus, the Applicant's and registrant's marks do not sound alike. Thus, there can be no confusion based on the sound of the Applicant's and the registrant's mark. It is thus very unlikely that any consumer

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could confuse the source of Applicant's and registrant's goods based on the sounds of their respective marks.

(c) Similarity in Connotation

The Trademark Examining Attorney made no comments about the connotation of the Applicant's mark, despite identifying it as a relevant factor.

A connotation is something suggested by a word or thing. When considered in their entirety, marks may have different connotations, because they suggest different things. Different connotations weigh against the marks being confusingly similar. *Aries Sys. Corp. v. World Book, Inc.* 26 U.S.P.Q.2d 1926, 1932 (TTAB 1993).

The registrant's mark, OPTI, in general suggests an option for something. In direct contrast, the Applicant's mark in general suggests to decide in favor of something.

Thus, the Applicant's and the first registrant's mark suggest different connotations with widely varying scope. Therefore, there is no confusion as to the source of the goods with respect to the connotations of the Applicant's and registrant's marks under the holdings of *Aries Sys. Corp.*

(d) Similarity in Commercial Impression

The Federal Circuit has held that even marks with identical sounds or appearance (which is not the case in this matter) may create sufficiently different commercial impressions when applied to the respective party's goods or services. *Aries Sys. Corp.*, 1932. If a mark creates a distinctly different commercial

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impression, the balance moves towards a lack of confusion *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992).

The Trademark Examining Attorney asserts that both marks are used to identify computer programs/software for text messaging or sending/receiving emails." The Applicant traverses this assertion.

First, nowhere in the registrant's description of goods are the words "text-messaging" mentioned at all, period. In addition, nowhere in the Applicant's description of goods is the term "email" mentioned at all, period. If the Trademark Examining Attorney is asserting that text-messaging and email are equivalent, she is incorrect. The Trademark Examining Attorney is urged to understand the differences between text messaging and email. They are simply not the same technology.

For example, an on-line computing dictionary, (<http://computing-dictionary.thefreedictionary.com/text+messaging>) defines "text messaging" as "short messages sent to a smart phone, pager, PDA or other handheld device. Text messaging implies sending short messages generally no more than a couple of hundred characters in length. In Europe, "text messaging" was popularized by the GSM cellphone system's Short Messaging Service (SMS), which supports messages of up to 160 characters."

The Applicant, at (<http://www.optit.com/providerfaq.html#1>) defines text messaging as "SMS (Short Messaging Service) also known as text messaging is the most cost-effective way of communicating to any mobile audience. Text Messaging

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via mobile phones using SMS (Short Message Service) allows short text messages (160 characters) to be received and displayed on mobile phones."

Clearly, neither of these definitions define, or are equivalent to, "email" as the Trademark Examining Attorney suggests. Email messages do not have a length restriction of 160 characters and are not sent via Short Message Services.

In addition, the Trademark Examining Attorney appears to give disproportionate weight to the fact that both the Applicant and registrant sell software and goods and services that are somehow related to sending electronic text in text messaging or email, which are clearly not equivalent technology. The Applicant asserts this view is also erroneous, due to the depth and breadth of computer related goods and services on the market.

As is aptly reasoned by the TTAB in *In re Quadram Corporation* 228 U.S.P.Q. 863,865 (TTAB 1985), "as a result of the veritable explosion of technology in the computer field over the last several years and the almost limitless number of specialized products and specialized uses in this industry, a per se rule relating to source confusion vis-a-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace. Tendencies toward applying 'per se' rules relating to likelihood of confusion in other fields have been struck down as being too inflexible and contrary to trademark law where each case must be decided based on its own facts and circumstances."

Accordingly, the overall commercial impression of Applicant's goods under the Applicant's design mark is that of software used for text messaging. The

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Applicant's goods are used for mobile devices such as mobile phones, personal digital/data assistant's (PDA), pagers and other mobile devices to send and receive text messages.

In direct contrast, goods under the registrant's mark include "a computer program for managing personal and business contacts; organizing personal information; keeping calendar and personal reminders; keeping history of contacts; keeping record of expenses; making phone calls; sending/receiving faxes and E-mail; and printing letters, labels, envelopes, phone books, address books, and contact details." The registrant's goods are used with stationary devices with more features such as personal computers. Such features are typically not available on a small hand-held mobile device. For example, it would be difficult to use the registrant's software to send and receive faxes and printing letters, labels, envelopes, phone books, address books, and contact details from a mobile phone, PDA, pager, etc.

Thus, the Applicant's and the first registrant's mark suggest significantly different commercial impressions. Therefore, there is no confusion as to the source of the goods with respect to the commercial impressions of the Applicant's and registrant's marks based on the holdings of *In re Hearst Corp.* and *In re Quadram*.

(e) Contrary Case Law

The following marks have been found NOT to be confusingly similar by the TTAB or Federal Circuit:

In re Bed & Breakfast Registry, 229 U.S.P.Q. 818 (Fed. Cir. 1986), BED
AND BREAKFAST REGISTRY, and BED AND BREAKFAST

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INTERNATIONAL both for lodging and reservation services.

In re Buckner Enters. Corp., 6 U.S.P.Q.2d 1316 (TTAB 1987), PALOMA, (Spanish for dove) and DOVE, for related goods.

In re Dayco Products-Eaglemotive Inc., 9 U.S.P.Q.2d 1910 (TTAB 1988), IMPERIAL, for automobiles and structural parts and IMPERIAL, for automotive products.

In re Hearst Corp., 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992), VARGAS, VARGA GIRL both for calendars.

In re Parfums Schiaparelli Inc., 37 U.S.P.Q.2d 1864 (TTAB 1995), SCHIAPARELLI, for fragrances and SCHIAPARELLI, for clothing and fashion accessories.

In re Broadway Chicken Inc., 38 U.S.P.Q.2d 1559 (TTAB 1996), BROADWAY CHICKEN and BROADWAY PIZZA, and BROADWAY BAR & PIZZA both for restaurant services.

In re Nobody's Perfect Inc., 44 U.S.P.Q.2d 1054 (TTAB 1997) (unpublished), NO BODY'S PERFECT, for feminine underwear and NO-BODY'S PERFECT, for apparel in retail stores.

Brewski Beer Co. v. Brewski Bothers, Inc. 47 U.S.P.Q.2d 1281 (TTAB 1998), BREWSKI BROTHER, for sport wear and BREWSKY'S for bar services.

Champagne Louis Roeder S.A. v. Delicato Vineyards, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998), CRISTAL, for champagne and CRYSTAL CREEK for wine

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Viacom International Inc. v. Komm, 46 U.S.P.Q.2d 1233 (TTAB 1998), MIGHTY MOUSE, for cartoon characters and the MY-T-MOUSE for graphical software of a computer mouse.

In re Digirad Corp., 45 U.S.P.Q.2d 1841 (TTAB 1998), DIGIRAY, for electronic digital x-ray system and DIGIRAD, for solid-state gamma ray radiation sensors.

Hard Rock Café Licensing Corp. v. Elsea, 48 U.S.P.Q.2d 1400 (TTAB 1998), HARD ROCK CAFÉ, for clothing, key rings, jewelry, and restaurant and take-out services and COUNTRY ROCK CAFÉ, for jewelry, beverage glassware, clothing, and restaurant and nightclub services.

In re Comexa Ltda., 60 U.S.P.Q.2d 1118 (TTAB 2001), AMAZON, for hot sauces and AMAZON, for restaurant services.

All of these cases include marks that at least as close as, or are closer in appearance, sound connotation and commercial impression than the Applicant's mark and the first registrant's mark.

(f) Conclusion – Appearance, Sound, Connotation and Commercial Impression

Based on the discussion above, the Applicant's and the registrant's mark themselves are not similar in appearance, sound, connotation or commercial impression. Thus, there is no confusion as to the source of the Applicant's the registrant's goods, and thus no likelihood of confusion between the marks.

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Accordingly, Applicant believes that the Trademark Examining Attorney has failed to make a *prima facie* case showing likelihood of confusion.

2. Relatedness of Goods and Services

Applicant traverses the Trademark Examining Attorney's assertion that conditions surrounding the Applicant's and registrant's marketing are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a common source.

(a) Marketing Activities

The Applicant and the registrant marketing activities are significantly different. The Applicant, markets its text-messaging software to retail establishment such as bars, restaurants, movie theaters, store, entertainment facility providers, that desire to provide real-time text-message based advertising to consumer with mobile devices such as mobile phones, PDAs, pagers, etc. (See www.optit.com/providers.html). The Applicant markets its software to high-tech, innovative consumers that are likely to try an unconventional type of focused real-time advertising provided via text messages.

In direct contrast, the registrant, markets its software via the Internet to a more general group of consumers who desire network simulation or an email server.

Thus, the marketing activities of the Applicant and the registrant are very clearly not the same. Therefore, there would not be any confusion towards the

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source of the Applicant's and registrant's services based on their respective marketing activities.

(b) Dissimilarity of Established and Likely-to-Continue Trade Channels

The Trademark Examining Attorney asserts that, with respect to Applicant's and registrant's marks, "the same consumers will be exposed to the goods identified with both of the marks." Applicant traverses this assertion, and submits as was described above, that the goods are sold through very different channels of trade.

The Trademark Examining Attorney is reminded that the existence of dissimilar established and likely-to-continue trade channels is an important factor that mitigates likelihood of confusion as to the source of services in the instant case. Even if the services are similar, and in this matter, they clearly are not, the established and likely-to-continue channels of trade are highly relevant factors in making a likelihood of confusion determination. *In re N.A.D., Inc.*, 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985). The Federal Circuit has also held there is less chance of likelihood of confusion if there is no conflict between two channels of trade. *In re Dixie Restaurants, Inc.* 41 U.S.P.Q.2d 1531, 1354 (Fed. Cir. 1997). See also, *In re The Shoe Works Inc.*, 6 U.S.P.Q.2d 1890, 1891 (TTAB 1988).

In the present matter, the Applicant and registrant operate in dissimilar established and likely-to-continue channels of trade. There is no conflict between these established and likely-to-continue channels of trade.

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A Google search for the registrant, using the search string "Unicom Sales Associates" and "New Jersey" yielded the following Google search entry on March 28, 2006:

Jersey City 3 Com Results (1021 - 1050)

Jersey City, NJ listing of 3 Com with phone numbers, driving distance, ...
Cranford, NJ 07016. Phone Number, 12.90 miles. **Unicom Sales Associates**
optnet.com ...

This search entry for the registrant lists a web-site as "optnet.com." The web-site at optnet.com states the web-site provides "Resources and information on Network Simulation and E-Mail Servers." The web-site also includes graphical tabs for universities, fax, engineering, tennis court equipment, management network, Internet, simulations and network modeling. There is no mention of text messaging on the registrant's web-site that the applicant can find.

Thus, the registrant's established and likely-to-continue trade channels include those consumers interested in obtaining information about network simulations and e-mail servers for stationary devices such as computers. In direct contrast, the Applicant has a web-site at "www.optit.com" The Applicant's web-site specifically states "The ... mobile messaging platform is a web-based platform for sending and receiving text messages. Opt It partners with local businesses, groups, associations and organizations to help them communicate more effectively with their customers and prospects. The Opt It Message Center allows

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you to provide up-to-date and unique special offers and promotions directly to your Opts Subscriber's mobile phones."

Thus, the Applicant's established and likely-to-continue trade channels include those consumers interested in purchasing a messaging platform for sending and receiving text messages to and from mobile devices.

Applicant and registrant sell their goods and services through widely different channels of trade to different consumer bases. This factor strongly mitigates against any likelihood of confusion under the holdings of *In re N.A.D.*, *In re Dixie Restaurants, Inc.*, and *In re The Shoe Works Inc.* Therefore, there would not be any confusion towards the source of the Applicant's and registrant's services based on their dissimilar established and likely-to-continue trade channels.

(c) Sophistication and Care in Purchasing

The Federal Circuit has held when there is care involved in making a purchase decision, there is less chance of a likelihood of confusion. *Electronic Design & Sales Inc. v. Electronic Data Sys. Corp.*, 21 U.S.P.Q.2d 1388, 1393 (Fed. Cir. 1992). The TTAB has similarly held that if the goods are purchased by consumers who are known to exhibit particular care in purchasing, there is less chance of likelihood of confusion. *Tricia Guild Assocs. Ltd. v. Crystal Clear Indus. Inc.*, 38 U.S.P.Q.2d 1313 (TTAB 1995).

Applicant's target market consists of very sophisticated purchasers involved in implementing focused electronic advertising campaigns using text messaging. In direct contrast, Registrant's target market also consists of another group of

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sophisticated purchasers involved in network simulations or looking for an e-mail server. Both products involved significant expenditures, both in terms of investing in the software and training personnel to use it. It is highly unlikely that a purchaser of text messaging software used to provide an advertising campaign for mobile devices provided by the Applicant would inadvertently confuse the software with network simulation or email server provided by the registrant, or vice versa.

Furthermore, both the Applicant's products involve policy and procedures to implement, because of privacy and other concerns as well as specific training of personnel to implement. The decision to purchase the Applicant's product may require the oversight of a board, comptroller, committee or chief operating officer within an organization. The fact that the purchasing of the Applicant's products is a corporate, departmental or entity-wide decision further increases the sophistication and awareness involved in making the purchase. The same holds true for the registrant's software.

In summary, Applicant has clearly demonstrated that there is no confusion as to the source of its goods and those of the registrant. Thus, the Applicant's mark is not likely to cause confusion, to cause mistake, or to deceive when used in association with the Applicant's goods in a marketplace including the first registrant's goods.

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***Summary – Failure of Trademark Examining Attorney to Make a
Prima Facie Case***

Applicant believes that the Trademark Examining Attorney has failed to make a *prima facie* case showing likelihood of confusion. Accordingly, the Applicant requests the Trademark Examining Attorney withdraw the Likelihood of Confusion refusal over the registrant's mark.

SPECIMEN

The Trademark Examining Attorney asserts that the Applicant must submit (1) a substitute specimen showing the mark as it is used in commerce on the goods or on packaging for the goods, and (2) a statement that "the substitute specimen was in use in commerce at least as early as the filing date of the application," verified with a notarized affidavit or a signed declaration under 37 C.F.R. §2.20.

The Applicant includes a substitute specimen and signed declaration under 37 C.F.R. §2.20.

Color Claim and Color Description of the Mark

The Trademark Examining Attorney asserts the applicant must submit the following: (1) a statement that "the colors red and white are claimed as a feature of the mark;" and (2) a separate description of where the colors appear in the mark, i.e., "the color red appears inside the two circles and the color while appears in the outline of the circles and in the wording OPT IT."

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The Applicant requests the Application be amended as follows:

the colors red and white are claimed as a feature of the mark;

and

**the color red appears inside the two circles and the color white
appears in the outline of the circles and in the wording OPT IT.**

OTHER REGISTRATIONS

The Applicant is the owner of prior registration 3,068,068 for the word mark,
OPT IT.

RESPONSE TO OFFICE ACTION E-MAILED: October 19, 2005
TRADEMARK 78/591,138

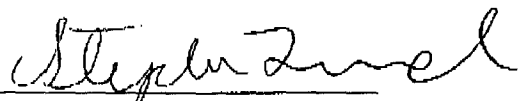
CONCLUSION

For these reasons, the Applicant requests that the Trademark Examining Attorney withdraw all the present refusals and immediately pass the present application to publication.

Respectfully Submitted,

**Lesavich High-Tech
Law Group, P.C. (32097)**

Dated: March 30, 2006


By: 
Stephen Lesavich

RESPONSE TO OFFICE ACTION E-MAILED: October 19, 2005
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DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares: that he/she is properly authorized to execute this Declaration on behalf of the Applicant; that a substitute specimen was provided; the substitute specimen was in use in commerce at least as early as the filing date of the application; that he/she believes the Applicant to be the owner of the trademark/service mark to be registered; and that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.


Date: 3/29/06

By: 
Mr. Michael Lamb
Title: Principal

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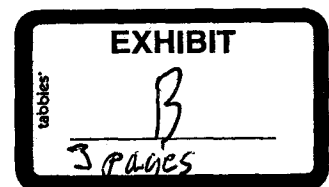
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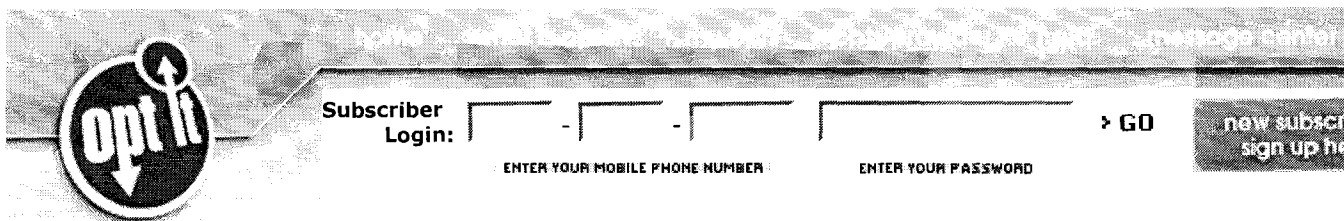
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In re Opt It Inc.
Serial No. 78/591,138



what is opt it?

We saw the need for a secure, trustworthy mobile messaging platform that subscribers can rely on to provide them with only the information they have requested. Unfortunately these days when you opt-in to receive information you invariably are bombarded with information you never requested.

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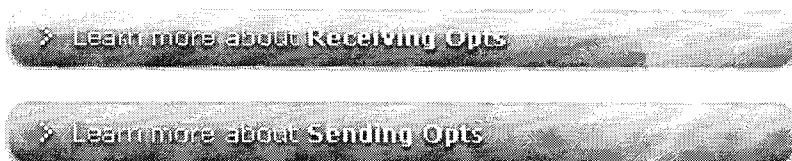
The Opt It mobile messaging platform is a web-based platform for sending and receiving text messages. Opt It partners locally with Opts Providers to provide **Opts** - special offers, promotions and updates. By providing Opts Provider's with a unique mobile domain name, Opt Subscribers can sign up for Opts:

- ❑ Directly from their mobile phone by texting an Opt It mobile domain name to IOPTN (46786).
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Our web based interface provides you with all of the information you need to send and receive messages, manage your account information and create a unique user experience.

Security and privacy are two of the areas we focus on as a company. We ensure that your personal information is secure and will never leave our network. Mobile phone numbers are never displayed to Opts Providers and you can unsubscribe at any time by texting the word "STOP" to IOPTN (46786). The subscriber is in control at Opt It.

To learn more about sending and receiving messages (Standard messaging rates apply) use the links below:



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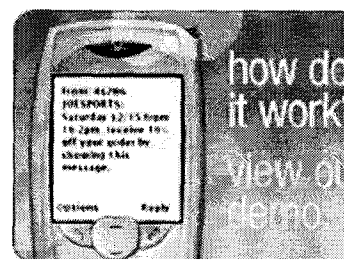
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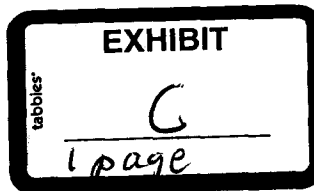
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SMS goes for a trial run

Dec 1, 1997 12:00 PM

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After more than a year of commercial operation, PrimeCo Personal Communications is tapping into the intelligence of its networks to unearth one of the advanced options intended to differentiate digital wireless.

PrimeCo will test short message services (SMS) with customers in Chicago and Milwaukee on the Lucent Technologies code division multiple access system the carrier has deployed in those markets. The test is the first phase of a rollout PrimeCo expects to complete by late next year.

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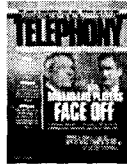
Optical Ethernet: Joseph Berthold is currently Vice President, Network Architecture at Ciena Corporation, where he contributes to the

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understanding of future network architecture directions, network service concepts, and the coordination of Ciena's work in industry standards.

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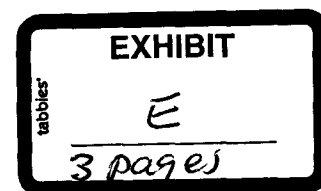
PRINTER FORMAT

Published Tuesday, June 26, 2001

Wireless text gains appeal

BY SHANNON TAN

stan@herald.com



In re Opt It Inc.

Serial No. 78/591,138

Jacsiry Lopez has only had her Nokia cellphone for a week, but she's already learned how to send text messages to her boyfriend.

"For him it's kind of troublesome," Lopez, 18, says of having to press the cellphone key pad repeatedly to send a short message. "It's quick for me."

The South Miami teenager is among a growing number of cellphone users -- usually 15 to 29 -- who are sending wireless text messages to their friends. In Europe and Asia, it's become a cultural phenomenon. An estimated 20 billion messages were sent last year worldwide.

In the United States, major cellphone companies are joining forces in a move that could make text-messaging more popular, by making it easier for all mobile devices to communicate with each other.

Other companies, like Upoc, MobileIM and the Message Distribution Center have already jumped on the bandwagon -- coming up with technology to connect all cellphones, pagers, PDAs and PCs and capitalize on the nearly \$2 billion texting market.

Texting is not quite like e-mail or instant messages. The text messages are limited to the size of your cellphone or pager -- usually 140 to 160 characters -- and it's impossible to tell whether the person you're sending the message to is online, offline, or away. The biggest difference, at least in the United States, is that there is not a common platform. A Sprint PCS user can't send messages to an AT&T cellphone, for example. The lack of uniform standards for texting led three of the world's top four handset makers -- Ericsson, Nokia and Motorola -- to announce their "Wireless Village" initiative in April.

"It's evident, looking at the development of instant messaging on the Internet today, that people have taken instant messaging to their hearts," said Jan Svensson, an Ericsson spokesperson. "Ericsson strongly believes that the Wireless Village initiative is a major step towards being able to provide a truly global instant messaging solution and also meet consumers needs also in the mobile world."

According to Mobile Lifestreams, a research company in the United Kingdom, 750 million text messages were sent last year in North America and a projected 10.5 billion by 2004 in the United States alone. Worldwide, the number of messages is projected to increase from 20 billion last year to 82 billion by 2004. This works out to a rise from \$1.73 billion in worldwide text-messaging revenue to \$6.6 billion in 2004.

But Charles Golvin, a senior analyst at Forrester Research, wonders if the text-messaging pie will be big enough for everyone.

"I don't believe that we'll ever see usage on the scale in the U.S. for short messaging that we see in other parts of the world," Golvin said. "One, societally, we're different. We're in our cars more. We're not in places where we have the opportunity to compose a message on your phone."

Also, while it's much cheaper to send a text message than to make a phone call in Europe, that's not the case in the United States, Golvin said.

First, "there needs to be seamless communication across carriers for messaging to take off," Golvin said.

That's what these new companies and the "Wireless Village" initiative aim to do.

Page 2

Upoc, the Message Distribution Center and MobileIM have come up with technology that routes text-messages to them before sending it on to other users -- who could be using cellphones, Internet-enabled phones, pagers, the Internet, or wireless PDAs.

Depending on the cellphone carrier, text messages can be free or cost anywhere from 2 cents to 10 cents each. Lopez, for example, does not pay for her messages with Voicestream. "I'll send a message to my boyfriend to meet him somewhere," she said.

Upoc (Universal Point of Contact) is a New York start-up that provides a wireless link between entertainment companies, artists and their fans. More than two dozen media companies such as Sony have signed deals with Upoc since its launch last October, in an attempt to promote artists to the 90,000 members who have joined the text-messaging service.

Want the 411 on Destiny's Child or Mandy Moore? Sign up with Upoc to get updates (sometimes voicemails from their singers themselves), hear clips, or enter contests -- all for free.

"These companies are paying for a way to reach their fans," said Upoc co-founder Greg Clayman. "Text-messaging is really easy and it's really short and it's really simple. You don't have to be in front of the computer, and young people are outside their home as much as they can be."

Search through the 5,000 user-created interest groups on Upoc and you'll find "South Beach Celebrity Sightings," or find a "one night stand" in Miami.

During this year's Winter Music Conference in Miami, Upoc sponsored several promotions, where party promoters and DJs would send text messages to let people know about their parties.

The Message Distribution Center -- which enables consumers to send text messages to anyone by entering the person's phone number -- was launched in March.

Last month, Mobile IM announced its technology that would allow a cellphone or other wireless device to connect to AOL's message system as well as similar products from Yahoo!, Microsoft and ICQ.

With MobileIM and Upoc, individual members create a screenname for themselves and can hide their real identity, phone numbers and e-mail addresses, similar to an instant-messaging system. Friends, families or businesses can form their own private groups, like chatrooms.

“There's definitely going to be some pretty good competition in this area,” acknowledged Jason Grovert, co-founder of MobileIM, which is based in Scottsdale, Ariz.

Overseas, texting is showing up in all aspects of life.

In Britain, the **first text-messaging** dictionary, WAN2TLK? Ltle Bk of Txt Msgs, was a paperback bestseller.

In January, when former Philippines President Joseph Estrada was toppled by an uprising, texting was used to organize a meeting point for about one million anti-Estrada demonstrators.

“The joke goes that President Estrada is the only chief of state in the world to be ousted by text messaging,” wrote the Manila Standard.

In Germany, a religious service was reduced to six text messages this year. A school in Singapore sends messages to parents when their kids play truant, while a British woman on a sinking boat off Indonesia was saved when she sent an SOS text message to her boyfriend in England.

In the United States, companies admit that it won't be easy for texting to achieve cult status as it has overseas.

“It's classic American -- everyone competing with each other,” said Upoc co-founder Clayman.

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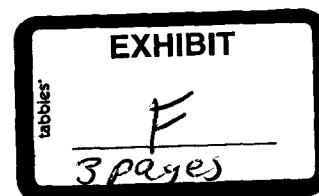
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SMS



In re Opt It Inc.
Serial No. 78/591,138

Introduction to SMS

by Chris Tull, AnywhereYouGo.com

Trapped in an incredibly boring meeting? All you need to do is whip out your trusty Palm or Nokia and tap out a message to one of your co-workers across the table: DID YOU SEE THE GAME LAST NIGHT?

Chances are you've heard about such messaging technology. But what's this technology's name? Is this technology something that is truly beneficial to the economic world? Or is it simply returning us to yesterday's classrooms—giving us a new way to pass notes behind the teacher's back.

What is this technology we're talking about?

Today, technology is moving towards the future of the wireless web. Mobile devices such as palmtops, handhelds, and cellular phones are becoming all the rage. People want these devices to do everything from access their e-mail accounts, to utilize the Internet, to access personal and corporate information.

One type of service that is available is a technology called SMS (Short Messaging Service). SMS is the technology that allows text messages to be received and sent over mobile devices.

Why use SMS?

SMS is a very inexpensive method of communication. 160 characters take up as much room as a one-second voice call. Messages are delivered immediately (or when the phone is turned on). Like e-mail, they can also be reviewed or stored in your phone for as long as you wish. SMS messages can also be sent out to huge groups of people with the single press of a button.

SMS also allows for unified messaging. This is where SMS can take on a number of different message formats (including voice mail, e-mail and fax) and allows users to access them from their mobile device.

Is SMS really that popular?

Yes! Europeans send each other well over a billion messages a month. This fact may be hard to believe if you live in the United States, where SMS service is practically nonexistent.

There are a number of reasons why the SMS is slow to take off in the United States. The main reason is that the United States does not use the digital wireless interface standard (GSM—more on this in a moment) that is necessary for SMS to function. Although GSM is starting to grow in the United States, the change is slow.

How does a mobile device have enough room to store information?

Most mobile devices can be fitted with SIM (Subscriber Identification Module) cards. These are plastic cards that, when placed in the back of a mobile device, store various types of information.

Isn't writing messages on a mobile device (like a phone) difficult?

You might be thinking that typing on a miniature telephone keypad is hard, even for nimble little fingers. Well, most devices contain 'predictive input', a sort of software that allows the device to guess what you are writing and try to finish the word for you. Besides, most people abbreviate their words anyway. Unless you're not trying to write a novel on your phone you should have no problems.

Can my mobile device use SMS?

For a device to utilize SMS, it must be SMS-enabled. Also, the device must be connected to one of the GSM networks that support SMS. Check with your device supplier to determine whether a device is able to receive SMS messages.

What do you mean by 'SMS-enabled'?

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SMS-enabled means that only devices with SMS technology built into them will be able to access and utilize SMS. Most mobile device manufactures such as Ericsson, Motorola, and Nokia offer SMS-enabled products.

What is GSM? What is a GSM Network?

GSM stands for Global Systems for Mobile Communication. SMS resides on GSM networks for SMS communication.

Back in the early 1980's, analog cellular telephone systems were growing rapidly in Europe. Each country started developing it's own system. These systems were incompatible with everyone else's equipment and operation. It was not a good situation. For one, mobile equipment was limited to their national boundaries. Thus, markets were limited for each type of equipment.

The Europeans realized this early on, and created a group to propose a new, universal system. This new universal system became GSM. Eventually commercial services became available in the early 1990's and GSM networks have spread worldwide.

GSM is a digital system, which is what allows SMS features to exist. Most countries use the GSM standard—the United States is one of the few countries to favor use of CDMA and TDMA standards over GSM (though there are GSM networks throughout the US). CDMA and TDMA allow extremely limited SMS capabilities.

GSM allows for messages to be sent from point-to-point, or in a cell-broadcast mode (point-to-omnipoint).

So, is GSM to remain the standard for SMS communication?

Probably not.

The world requires more and more Internet functionality from their mobile devices. And GSM, in all its complexity, is having a hard time keeping up. GSM was never designed to service text information, let alone large amounts of text such that the wireless Internet would provide. Using GSM for anything more than SMS would become a slow and cumbersome method.

With that said, it seems that GPRS (General Packet Radio Service) is being touted as the new best thing. GPRS would allow the sending of Internet information through mobile devices at a high speed. Experts believe that GPRS will be capable of delivering information at a speed of up to 100,000 bits per second.

Currently, GSM can deliver information at a speed of 9,600 bits per second.

What's point-to-point?

A point-to-point SMS message is where a user sends a message to another subscriber in their service. Once their message is sent, an acknowledgement of receipt is provided to the sender.

What's cell-broadcast mode?

Cellbroadcast mode, or point-to-omnipoint, SMS messages are those such as traffic updates or news updates that are sent by services to multiple subscribed users within a given cell area.

Where can I find out more information about SMS?

If you've never tried SMS, I urge you to check it out. It's an incredibly practical, reliable, and affordable method of communication.

For more information about SMS, check out our site numerous articles and updates on the latest developments with SMS. Also, you can check out www.gsmag.com for great information about anything and everything happening within the GSM world today—including SMS and much more.

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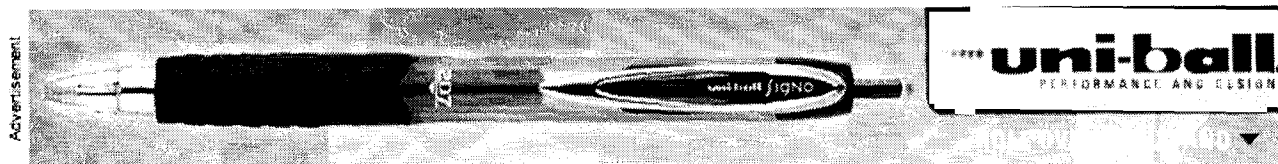
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Posted 7/27/2005 10:33 PM

Surge in text messaging makes cell operators :-)

By Kevin Maney, USA TODAY

It takes the number of characters in this paragraph — just 160 — to flirt, avoid traffic jams, balance your checking account, help Africa and win a generation.



Until the past year, young people like sixteen-year-old Tory Jones used to be the main users of the text messaging function on cell phones.

By Jack Dempsey AP

Text messaging on cell phones is finally taking off in the USA. It has been around for years and is a huge part of life in Japan and South Korea. But in the U.S. market, text messaging had caught on only among teens and *American Idol* fans voting for their favorites — until the past year or so.

Now this seemingly bare-bones medium — a message limited to 160 text characters transmitted to a cell phone screen for a few cents — is a raging phenomenon.

"It's clearly exploding," says Sky Dayton, co-founder of Earthlink and who is now running a U.S. joint venture, SK Earthlink, with South Korea's biggest cellular operator. "It's an example of how a medium evolves into something you never expected it to. Who knows where it will go from here."

About 5 billion text messages are sent a month in the USA, up from 2.8 billion a year ago, according to the wireless trade association CTIA. But the real story is in the inventive ways this medium is being used and penetrating everyday life.

What's it mean?

A text message exchange could look like:

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Live 8, the global series of rock concerts July 2, generated 26 million text messages worldwide in support of debt relief for African nations. At U2 concerts this summer, fans can text their names to show up on a giant screen behind the band — and register to be part of lead singer Bono's poverty-fighting ONE Campaign.

Sports teams are starting to use "texting" to bond with fans. Hair salons can use it to remind customers of appointments. You can sign up to get



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WIIFM
DNR
SLAP
G2G
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OO

text updates about traffic on your commuting route and weather in your hometown. *Teen People* magazine will automatically text you breaking news about such weighty issues as Scarlett Johansson's love life. At SMS.ac, which wants to be the Yahoo of text messaging, guys can sign up to get a new pickup line every day.

Scroll down for a translation.

Much more is coming as marketers and municipalities wake up to the possibilities. "We're starting to see major brands utilize text messaging," says Alex Campbell, CEO of Vibes Media, which has helped McDonald's, Budweiser and the Chicago White Sox with text-messaging campaigns. "That's new." It's also just a teaser for innovations to come, such as when text messaging merges with other new technologies such as location-based services that can pinpoint a cell phone.

Making a connection

A number of factors are finally converging into a perfect text-messaging storm in the USA. For starters, there's the sheer mass of text-capable phones out there: Of 192 million active mobile phones in the USA, 90% have screens and can handle text messages, CTIA says.

"Mobile phones have become the third screen in people's lives," says Neville Street, CEO of messaging company Mobile 365, the other screens being the TV and PC. "But this one is more personal," Street says. All of those phones, however, awaited a key that would unlock a texting boom: interoperability.

Unlike in other parts of the world, the U.S. cell phone market has multiple carriers using different, incompatible wireless networks. Just a couple of years ago, a text message sent from, say, a Verizon phone often couldn't get to a Cingular phone. The only way texting would take off was if it could be more like e-mail, reaching any device over any network.

Enter Mobile 365, the nation's biggest cross-network mobile-messaging-delivery service, along with some of its smaller competitors. Their services take in text messages sent from one network and transfer it into another, so any message can reach any phone. Now, about 45% of all text-messaging traffic flows between previously incompatible networks.

In the meantime, many Americans have grown accustomed to typing on tiny keys using their thumbs. Speeding the process is a character-saving body of accepted texting shorthand: BRB means "be right back." TTYL is "talk to you later." (For a whole dictionary, check out <http://www.txt2flrt.com/content/lingo.aspx>.)

Cultural factors also play a role in text messaging's surge. Teenagers have made it a routine way to communicate. About 63% of Americans from ages 18 to 27 text message, according to a Pew Internet & American Life Project survey out in March. Those teens are bringing texting to their parents — or are moving into the workforce and texting with older colleagues. Now 31% of cell phone owners ages 28 to 39 use text, and 18% of those 40 to 49 do, Pew reports.

In addition to *American Idol*, other reality TV shows, such as *Dancing With the Stars*, ask viewers to text in votes. Movies such as *Bridget Jones: The Edge of Reason* depict characters texting each other. All that has helped make texting popular, experts say.

Now comes another element that will drive up text messaging: Services that give people more to do with the medium than just chat.

Flirting to alerting

At www.txt2flrt.com, you can sign up to use text messaging to help find a date. Fill out a profile on the Web, and then all you have to do is text the word "MATCHME" to the service. A computer finds a potential match and sends back a few lines about that person — but no names. Respond if you want to start a conversation, and the system will forward your message on to the match. SMS.ac has a similar flirting mechanism, but adds photos. (SMS stands for "short messaging service," another term for text messaging.)

Some other emerging twists on text messaging:

•**Texting to big screens.** The most high-profile example can be seen at U2 concerts this summer. Bono makes an on-stage pitch for ONE and asks people to sign up by texting in their names. Audience members pull out their cell phones. As the names roll in, they are projected on a giant screen. Texting firm Vibes Media helped Anheuser-Busch run a promotion using text-to-screens in bars. Patrons could send a message to the bar's video system or to a special screen Vibes set up. Software filters block inappropriate text. Within minutes, Vibes CEO Campbell says, "it usually turns into a lot of flirting." Look for the technology to come to sporting events. At some Los Angeles Angels baseball games this year, fans could send text to the scoreboard between innings.

•**Practical texting.** Since text messages arrive on a phone that you're likely to have with you all of the time, certain kinds of messages could help smooth everyday life. For instance, traffic alerts. San Diego residents can sign up for the San Diego Wireless Traffic Report and get text alerts when their commuting routes are clogged. MSN Autos offers a text-message traffic-incident report for dozens of metro areas.

Several services offer weather alerts by ZIP code. One idea that might come to U.S. cities: pollution alerts. In June, London authorities said asthma sufferers could sign up for a free service that would send them text messages about elevated air-pollution levels. Governments around the world are experimenting with ways to use text messages to warn of disasters such as approaching tsunamis and tornados, and to broadcast escape routes in the event of terrorist attacks.

Text message exchange

HRU — how are you?

WU — what's up?

WRUD — what are you doing?

IMTNG — I'm in a meeting

MSULkeCrZ — miss you like crazy

LtsGt2gthcr — let's get together

WIIFM — what's in it for me?

DNR — dinner

SLAP — sounds like a plan

G2G — got to go

B4N - bye for now

OO — over and out

•**Texting to sell.** Unlike e-mail, each text message can cost the sender as much as 10 cents, and getting the message can also cost the receiver a penny or more. So massive spamming is less likely to become a problem. However, opt-in services — in which the consumer requests certain information — are catching on among marketers. The concept is more about building relationships than sending junk mail. Mobile 365 has worked with Citibank to create a service that would send text to your phone when your checking-account balance falls below a certain amount. Salon.Textalert.com offers hair salons a way to update their customers about appointments and special offers.

Vibes worked with baseball's White Sox to devise a text-message-based game of trivia about the team. The game so hooked fans that it averaged 44 messages exchanged per user. Major League Baseball's MLB.com has developed a package of text-message offerings, including scores, trivia and injury updates, for \$3.99 a month — essentially getting consumers to pay for incoming marketing messages.

Proliferating possibilities

Expect the innovations to keep coming. Many of them will be imports of services already offered in Asia. At SK Earthlink, co-founder Dayton's job is to bring applications from South Korea to the U.S. market. Though he won't say specifically what might be introduced here, he points out some of the more interesting services in South Korea. One of those is the buddy finder. "I think that will be part of the next wave — phones that are 'location-aware,'" Dayton says. A user can agree to allow the location of his or her phone to be seen by certain people or groups of people.

If a colleague is late for a meeting, call up a map on the Web and see where he is. At a big event such as a concert or sports game, you could program the service to alert you if anyone in your buddy list is there. The location-based service would be able to tell whether that person entered the area. Then you could text that person and make a plan to meet.

In Japan, NTT DoCoMo is experimenting with bar-code readers on cell phones. If you like a product you see in a store, you could zap the barcode and get text with more

information about the product — and maybe prices from competing retailers. It's one of many technologies DoCoMo is evaluating for the U.S. market.

Layered on all that, users are increasingly adding photos and video to text messaging. Mobile 365 is already handling 2 million picture messages a month. All in all, the next few years promise to be a text-messaging bacchanal. HCIT? G2G!*

(*How cool is that? Got to go!)

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Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

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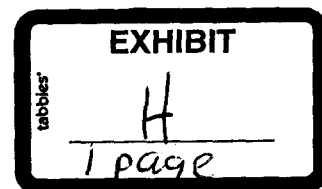
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LINDA POWELL, EXAMINING ATTORNEY



In re Opt It Inc.
Serial No. 78/591,138

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Serial No. 78/591,138

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Serial Number 78/591773

EXAMINER'S AMENDMENT

OFFICE RECORDS SEARCH: The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

ADVISORY – AMENDMENTS TO GOODS/SERVICES: If the identification of goods and/or services has been amended below, any future amendments must be in accordance with 37 C.F.R. §2.71(a) and TMEP §1402.07(e).

AMENDMENT(S) AUTHORIZED: As authorized by Stephen Lesavich on October 17, 2005, the application is amended as noted below. *If applicant disagrees with or objects to any of the amendments below, please notify the undersigned trademark examining attorney immediately.* Otherwise, no response is necessary. TMEP §707.

Amendment of Recitation of Services:

The recitation of services is amended to read as follows:

Advertising services, namely, providing special offers, promotions and updates for others via text messaging, in IC 035.

/Linda A. Powell/

Trademark Examining Attorney

Law Office 104

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